

can “wrap a device and its magnet can secure the wrap to a magnetic surface.” Applicant agrees that Nielsen discloses a wrapped magnetized brush retainer, but Applicant respectfully traverses the rejection because Nielsen does not suggest an elongated element for encompassing a device while exposing an opening or openable portion of the device.

The claimed holder comprises an essentially elongated element having two ends, a first surface, a second enjoining surface, at least one attachment means at opposite ends on each of the surfaces, and a magnetic means that is positioned on the first surface. It is designed to fit about a liquid-containing device that has an opening or openable portion so that the opening or openable portion remains exposed and, therefore, accessible to a user.

The Nielsen reference only shows a storage retainer for a paint brush that requires multiple panels in a cross-shape for fully retaining and enclosing the brush. The panels fold over and fasten on one another. The panels are designed to cover and completely enclose the brush bristles. The Nielsen retainer serves to protect the brush, as a “keeper,” and is specifically provided as an alternative to traditional paper covers. *See* Column 1, lines 37-38.

Prior art is insufficient to form a basis for establishing unpatentability unless the art also contains some teaching, suggestion or incentive to look to particular sources of information, to select particular elements, and to combine them to arrive at the claimed invention. *See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir. 1990). Regardless that Nielsen contains folding panels with hook and loop fasteners and a magnetic means, it simply contains no suggestion to one skilled in the art that its dimensions could be redesigned to employ an elongated element. Moreover, nowhere does Nielsen suggest that it could hold a liquid-containing device while leaving exposed an opening or openable portion of the device. Instead

the Examiner improperly reads “teaching” into the reference that simply does not exist to incorrectly conclude that the Nielsen brush retainer shows the claimed holder device.

In fact, Nielsen specifically teaches away from an elongated element that encircles a device while exposing an opening or openable portion thereof in that Nielsen requires multiple panels be attached to each other in multiple places to enclose a device. In the Nielsen reference, the brush retainer is designed to have multiple flaps to protect and keep brushes, requiring that the bristles be completely enclosed within the flaps. Such teaching away is the antitheses of the suggestion that one of ordinary skill in the art go in the direction of the claimed invention.

Teaching away from the art is a *per se* demonstration of lack of *prima facie* obviousness. In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988). Even if the Nielsen flaps were not all fastened or if Nielsen were simply an elongated element, it could not function as a storage device for keeping brushes while still utilizing a magnetic means. Furthermore, it is contrary to this purpose to suggest leaving the brush bristles exposed for use, as with the opening or openable portion of the liquid-containing device of the claimed invention.

Furthermore, Nielsen does not show or disclose a magnet in a bottom portion of the retainer as in claim 14. In fact, the Nielsen retainer does not have a bottom portion, *per se*, because it is not designed to support the brush from the bottom, bristle edge, but rather to minimize pressure to the bristles. For at least all of the foregoing reasons the Nielsen reference does not teach or suggest to one skilled in the art the claimed holder device. Accordingly, the Nielsen reference cannot form a proper basis on which to obviate the claimed holder device.

With regard to the Examiner's rejection of the dependent claims 3-13, the Examiner has generally dismissed the limitations without providing any specific evidence that the additional limitations in these claims are disclosed in or suggested or taught by prior art. A rejection based

on section 102 or 103 must rest on a factual basis, which means the Examiner has a duty to specify the prior art relied on and to describe where in the prior art there is a teaching or suggestion of the claimed features. It is improper for the Examiner to resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.

See In re Warner, 379 F.2d 1011 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The Examiner's rejection of dependent claims 3-13 is without necessary supportive evidence, thus the Examiner has not met the burden of establishing a *prima facie* case of anticipation or obviousness with respect to these claims.

Applicant respectfully submits that the patent application and the claims, as amended, therein are in a condition for allowance. Accordingly, reconsideration and allowance of the claims are respectfully requested.

Applicant would appreciate the courtesy of a telephone call should the Examiner have any questions or comments with respect to this response or the claim language for purposes of efficiently resolving same.

Respectfully submitted,

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APPENDIX A

Please find below claims 1, 12 and 13 marked-up to show the changes incorporated in the above amendment:

1. (twice amended) An improved holder for a liquid-containing device, said device having an opening or openable functionable portion, comprising an essentially elongated element having two ends, a first surface, a second enjoining surface, at least one attachment means on each of said surfaces at opposite ends of said surfaces, and a magnetic means positioned on or in a portion of said first surface wherein said elongated element encircles said device ~~while having exposable said functionable portion thereby exposing said opening or openable portion.~~

12. (twice amended) A method for removeably affixing a liquid-containing device having an opening or openable portion to a magnetic accepting surface comprising of encircling said device with an essentially elongated wrap element formed with two attachable overlapping ends thereby leaving said opening or openable portion exposed, said wrap element having an outer surface with a magnetic means portion or magnet imbedded therein or attached thereto, and mounting said wrap element in combination with said device to said magnetic accepting surface.

17. (amended) An improved holder as set forth in claim 1 wherein said functional portion comprises opening or openable portion provides a drinking portion.